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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,862	10/27/2003	Claude Petit	T2147-907881US02	9204
181	7590	01/14/2005		
MILES & STOCKBRIDGE PC 1751 PINNACLE DRIVE SUITE 500 MCLEAN, VA 22102-3833			EXAMINER TRINH, MINH N	
			ART UNIT 3729	PAPER NUMBER

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,862

Applicant(s)

PETIT ET AL.

Examiner

Minh Trinh

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-29 is/are pending in the application.
- 4a) Of the above claim(s) 19-24 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/27/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election with traverse of Group II (claims 25-28) in the reply filed on 10/08/04 is acknowledged. The traversal is on the ground(s) that the examiner has not established a prima facie case of serious burden of examination of the inventions of Groups I, II and III together. This is not found persuasive because the examiner has, established a prima facie case having shown in prior Office action (see paragraphs 1 & 2) that the inventions I-III, each clearly has a separate classification and a separate status in the art and require a separate field of search. Furthermore, the mounting a first electrical component on a second side of the printed circuit card can be practice by hand or by others instead of the device invention I. In accordance with MPEP §803, the examiner has demonstrated that the inventions of Group I, II and III are each independent or distinct as claimed (as indicated in prior Office action, paragraph 1). Applicants' reasons therefore are not persuasive, because examination of the independent inventions herein would present a serious burden to the Examiner in as much as the searches are not coextensive and the art is quite prolific Accordingly, the requirement is repeated and **MADE FINAL**. Applicants therefore are requested to cancel all non-elected claims or take other appropriate action.

2. Claims 19-24 and 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention (I and III), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election)

requirement in the reply filed on 10/08/04. Thus, an Office action on the merits of elected claims 25-28 as follows:

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed subject matter of “inserting a chock on a first side of the card”(claim 25, line 5); “placing a package tool on a horizontal support” (claim 25, line 12) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The Abstract

4. The abstract of the disclosure should have been modified to read on the method invention and in a single paragraph limit to 50-100 words. Correction is required. See MPEP § 608.01(b).

Specification

5. The disclosure is objected to because it does not describe what is a chock that is associated with the claimed method. At best it describes the mounting is done by means of a chock (see page 6, paragraph 0049) Applicants be required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art. Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 25-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case the specification does not clearly disclose a chock that being operatively associated with the method set forth in the claims 25-28 in a way as to enable one skilled in the art to use the invention.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are examples:

a) "said printed circuit "(claim 25, line 2) lacks proper antecedent basis.

b) "the card" (claim 25, line 5) lacks proper antecedent basis.

c) The scope of the invention is directed to a method and the claims recited the structural limitation directed to "a package tool . . . comprises a plurality of springs " which make the scope of claims unclear.

d) it is also not clear whether "an electrical component assembly" (claim 25, line 6) is at least one of the "electrical component assemblies" (preamble, line 1) and what is this in relation with "a first electrical component " (claim 25, line 10). Please clarify.

e) "the package"(claim 25, line 16) lacks proper antecedent basis.

f) the step of "mounting a second electrical component assembly on a second side of the printed circuit card"(claim 25, line 19) is confusing in that it is not known whether "a second side "(claim 25, line 19) is the same as "a second side "(claim 25, line 10), since the first electrical component has been mounted on the second side of the printed circuit card (see line 10).

Further, Applicants should carefully revise the claims languages to positively recite the manufacturing method steps.

10. Regarding claims 25-28. It is noted that no art rejections have been applied to claims 25-28, since there are a great deal of confusion an uncertainty as to the proper interpretation of the limitations of the above claims. Therefore, it would not be proper to reject such claims on the basis of prior art. See MPEP 2173.06.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited for their teaching of method for assembling PCB or the like.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (571) 272-4569. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mt



Minh Trinh 12/16/04
Primary Examiner Group 3700